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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,713	11/30/2000	Naoaki Nii	017.39114X00	1256

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ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 NORTH SEVENTEENTH STREET  
SUITE 1800  
ARLINGTON, VA 22209-9889

[REDACTED] EXAMINER

GART, MATTHEW S

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3625

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/725,713	NII, NAOAKI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Matthew S Gart	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-48 is/are pending in the application.
  - 4a) Of the above claim(s) 29-48 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 November 2000 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                               | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3 and 7</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-28, drawn to a multimedia content delivery system and process, comprising a first integrated circuit card and a second integrated circuit card, classified in class 705, subclass 26.
- II. Claims 29-48, drawn to a method and system in distributing electronic content to a terminal device, comprising the step of storing in a memory module tailoring information defining electronic content that is transferable to the terminal device, classified in class 705, subclass 26.

The inventions are distinct, each from the other because of the following reasons:  
Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as storing in a memory module tailoring information defining electronic content. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

During a telephone conversation with James Dresser on August 27<sup>th</sup>, 2002 a provisional election was made without traverse to prosecute the invention of Group I,

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claims 1-28. Applicant in replying to this Office action must make affirmation of this election. Claims 29-48 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Drawings***

This application has been filed with informal drawings, which are acceptable for examination purposes only. The figures contain improper shading and crowded text which may affect clarity when reproduced.

Applicant is required to submit a formal correction of the noted defect. Applicant is required to submit drawing corrections promptly. Drawing objections may no longer be held in abeyance.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramachandran U.S. Patent No. 6,457,640 in view of Findley U.S. Patent No. 5,979,773.**

Referring to claim 1. Ramachandran discloses a multimedia content delivery system, comprising

- A content provider having a plurality of multimedia files therein (abstract);
- An input device for selecting a multimedia file from the plurality of multimedia files (abstract, "16");
- An output device for selecting a multimedia file from the plurality of multimedia files (abstract, "18"); and
- A first integrated circuit card interface for receipt of a host integrated circuit card containing first authorization information (abstract, "20");

Ramachandran does not expressly disclose a system comprising:

- A second integrated circuit card interface for receipt of a user integrated circuit card containing second authorization information; and

- A control unit responsive to insertion into said second integrated circuit card interface of a user interface card containing second authorization information compatible with the first authorization information contained in a host integrated circuit card inserted in said first integrated circuit card interface, for actuating said output device to provide the content of a multimedia file selected by said input device.

Findley discloses a system comprising:

- A second integrated circuit card interface for receipt of a user integrated circuit card containing second authorization information (Fig. 1, "A"); and
- A control unit responsive to insertion into said second integrated circuit card interface of a user interface card containing second authorization information compatible with the first authorization information contained in a host integrated circuit card inserted in said first integrated circuit card interface, for actuating said output device to provide the content of a multimedia file selected by said input device (abstract).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Ramachandran to have included the system of Findley in order to provide an electronic data access and retrieval system for accessing and retrieving digital data information securely (Finley: column 5, lines 9-15).

Referring to claim 2. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system comprising a multimedia terminal having said content provider, said first integrated circuit card interface said control unit therein enclosed therein (Fig. 2).

Referring to claims 3-4. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said output device comprises an audio and video output device (column 7, lines 49-59).

Referring to claim 5. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said output device comprises a communication link permitting downloading of the selected multimedia file in electronic form (column 7, lines 49-59).

Referring to claim 6. Ramachandran in view of Finley discloses a system according to claim 5 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said communication link is a wireless communication link (column 4, lines 37-49).

Referring to claims 7-8. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said input device, said output device, and said control unit comprise a laptop computer and a wireless personal terminal (column 4, lines 37-49).

Referring to claim 9. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said content provider comprises a server (Fig. 1).

Referring to claim 10. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said content provider further comprises a mainframe computer coupled to said server (Fig. 1)

Referring to claim 11. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system comprising a server connected to said content provider (Fig. 1).

Referring to claim 12. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system comprising a mainframe computer connected to said server (Fig. 1).

Referring to claims 13-14. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said multimedia files comprise audio and video media (abstract).

Referring to claims 15-18. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said video media comprises text, books, newspapers and games (column 6, lines 53-62).

Referring to claim 19. Claim 19 is rejected under the same rationale as set forth above in claim 1.

Referring to claim 20. Claim 20 is rejected under the same rationale as set forth above in claim 1 and 2.

Referring to claim 21. Claim 21 is rejected under the same rationale as set forth above in claim 3.

Referring to claim 22. Claim 22 is rejected under the same rationale as set forth above in claim 4.

Referring to claim 23. Claim 23 is rejected under the same rationale as set forth above in claim 5.

Referring to claim 24. Claim 24 is rejected under the same rationale as set forth above in claim 1.

Referring to claim 25. Claim 25 is rejected under the same rationale as set forth above in claim 1 and 2.

Referring to claim 26. Claim 26 is rejected under the same rationale as set forth above in claim 3.

Referring to claim 27. Claim 27 is rejected under the same rationale as set forth above in claim 4.

Referring to claim 28. Claim 28 is rejected under the same rationale as set forth above in claim 5.

### ***Conclusion***

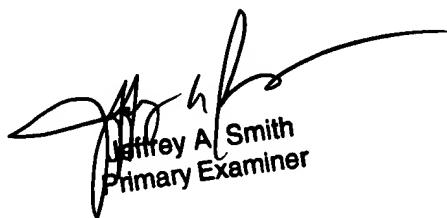
Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG

August 28, 2003



Jeffrey A. Smith  
Primary Examiner